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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,267	11/21/2001	Robert O'Kane	38/146	4992

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EXAMINER

MEUCCI, MICHAEL D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/002,267	Applicant(s) O'KANE ET AL.	
	Examiner Michael D Meucci	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Requirement for Information

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 13 recite the limitation "the network resources" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6, 8, 10-16, and 18-20 provisionally rejected under the judicially created doctrine of double patenting over claims 1-6, 8, 10-16, and 18-20 of copending

Application No. 09/683228. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Claims 1-6, 8, 10-16, and 18-20 in the instant application are identical to corresponding claims 1-6, 8, 10-16, and 18-20 in application 09/683228

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claims 7 and 17 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 17 of copending Application No. 09/683228. Although the conflicting claims are not identical, they are not patentably distinct from each other. If multiple advertisements are displayed, the user must make a selection as to which advertisement they would like to view from the plurality of advertisements.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

8. Claims 1-20 rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The claims of application 09/683228 contain near identical subject matter which leads the examiner to believe that Chris Ricci, who is not named as co-inventor on application 09/683228, may or may not be co-inventor of the instant application.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4-5, 9, 10-11, 14-15, and 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. (U.S. 6,636,854 B2) hereinafter referred to as Dutta in view of Smith et al. (U.S. 6,473,749 B1) hereinafter referred to as Smith.

a. As per claims 1 and 11, Dutta teaches: a plurality of computer connected in a peer-to-peer fashion (abstract); one or more software applications associated with the computer systems for allowing the computer systems to publish and retrieve content

from the network by initiating peer-to-peer interactions across the network (lines 23-34 of column 6);

Dutta fails to teach: using a user based digital trigger acknowledgement. However, Smith discloses: "Likewise, file content management system 106 may generate charge data when data structures are accessed by a user of a download client 104 from file content management system 106, which may transmit the charge data for such data structures to charge tracking system 208," (lines 54-59 of column 6).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use a user based digital trigger acknowledgement. "In this manner, a user of upload client 102 that authors file content may access charge tracking system 208 in order to determine the current charges assigned for various data structures, charges accumulated by users of download client 104, and other suitable charge data," (lines 59-63 of column 6 in Smith). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to use a user based digital trigger acknowledgement in the system and taught by Dutta.

b. As per claims 4 and 14, Dutta teaches: the interactions are performed by the client-server applications (lines 28-30 of column 1 and lines 51-55 of column 4).

c. As per claims 5 and 15, Dutta fails to teach: each interaction across the network involves a transaction cost. However, Smith discloses: "File content management system 106 may also track charge and credit information for each data structure. For example, the user of upload client 102 may be an author or other similar user that creates file content on a fee basis. Likewise, the users of download client 104

may be purchasers of such content. In another exemplary embodiment, the user of upload client 102 and the user of download client 104 may both be employed by the same enterprise, and the charge system may be used to allocate marketing, research, engineering or other charges to products, customers, projects, or other suitable cost-tracking categories,” (line 66 of column 4 through line 9 of column 5).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have each interaction across the network involve a transaction cost. “File content management system 106 may be configured to track such charge and credit data so as to allow tracking of overhead costs,” (lines 9-12 of column 5 in Smith). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have each interaction across the network involve a transaction cost in the system as taught by Dutta.

d. As per claims 9 and 19, Dutta teaches: the parts of the network may be connected through a wireless connection (lines 16-19 of column 3).

e. As per claims 10 and 20, Dutta teaches: the system keeps track of the content (abstract). This is inherent in the system because all computers must have a way to retrieve content from its hard disks and/or memory.

11. Claims 2 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta and Smith, further in view of Sankaranarayan et al. (U.S. 6,799,208 B1) hereinafter referred to as Sankaranarayan and Paiz (US PG Pub. 2001/0037304 A1).

Dutta fails to teach: the computer systems have characterized network resources that can be contributed to the network in return for viewing an advertisement.

However, Sankaranarayan discloses: "When a configuration is populated, one or more resource descriptors are added to the configuration by each of the resource providers that contribute a resource to perform a particular task with which the activity is associated," (lines 17-21 of column 23). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have network resources that can be contributed to the network. "The resource providers <that> contribute a resource to perform a particular task with which the activity is associated," (lines 19-21 of column 23 in Sankaranarayan). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have network resources that can be contributed to the network in the system as taught by the combination of Dutta and Smith.

Paiz discloses: "The method still further preferably includes additional the steps of delivering advertising matter to the end user with each work the end user selects and plays," (abstract). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to contribute resources to the network in return for view an advertisement. "An apparatus for performing the method is also provided, including a computer hive made up of several inter-linked computers having specialized functions, the computers operating in unison to build a supercomputer that has shared disk space and memory, in which each node belongs to the collective and possesses its own business rules and membership to an organization

managerial hierarchy,” (abstract of Paiz). It is for this reason that one of ordinary skill in the art at the time of the applicant’s invention would have been motivated to contribute resources to the network in return for view an advertisement in the system as taught by the combination of Dutta and Smith.

12. Claims 3 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta and Smith, further in view of Siu et al. (U.S. 6,522,641 B1) hereinafter referred to as Siu.

Dutta fails to teach: the network resources include any of disk space, bandwidth, and CPU processing cycles. However, Siu discloses: “TDMA systems are designed to share bandwidth among many users,” (lines 11-12 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to have network resources include any of disk space, bandwidth, and CPU processing cycles. “TDMA systems are designed to share bandwidth among many users, thus allowing for its greater efficiency when dealing with bursty traffic sources. TDMA systems allow for bandwidth sharing, thereby providing for multiple bursty or low bit rate users to access the channel,” (lines 11-16 of column 3 in Siu). It is for this reason that one of ordinary skill in the art at the time of the applicant’s invention would have been motivated to have network resources include any of disk space, bandwidth, and CPU processing cycles in the system as taught by the combination of Dutta and Smith.

13. Claims 6-8 and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta and Smith, further in view of Goldberg et al. (U.S. 6,183,366B1) hereinafter referred to as Goldberg.

a. As per claims 6 and 16, Dutta teaches: retrieving content (lines 10-15 of column 7).

Dutta fails to teach: retrieving content in return for view an advertisement. However, Goldberg discloses: "Compensation to users for viewing advertising may also be provided," (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to retrieve content in return for view an advertisement. "The present invention provides an information exchange service within a gaming context for enticing players to view and/or interact with sponsor presentations such as interactive advertisements," (lines 14-17 of column 4 in Goldberg). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to retrieve content in return for viewing and advertisement in the system as taught by Dutta and Smith.

b. As per claims 7-8 and 17-18, Dutta fails to teach: content can be retrieved in return for an advertisement being viewed when using the content and when retrieving the content; and the user can select the advertisement from a plurality of advertisements.

However, Goldberg discloses: "Compensation to users for viewing advertising may also be provided. For instance, users may be provided with subsidized Internet

access for receiving advertising while concurrently interacting with an Internet service. Users may also be provided with various games and/or game tournaments via interactive network communications," (abstract).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to retrieve content in return for an advertisement being viewed when using the content and when retrieving the content. "Thus, users may respond to advertising while being entertained (e.g., via games), or while interacting with another network service," (abstract of Goldberg). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to retrieve content in return for an advertisement being viewed when using the content and when retrieving the content in the system as taught by Dutta and Smith.

It is inherent that the user can select the advertisement from a plurality of advertisements. If multiple advertisements are displayed, the user must make a selection as to which advertisement they would like to view from the plurality of advertisements.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beckerman et al. (U.S. 6,029,200) discloses automatic protocol rollover in streaming multimedia data delivery system.

Dwek (U.S. 6,248,946 B1) discloses multimedia content delivery system and method.

Fanning et al. (U.S. 6,366,907 B1) discloses real-time search engine and Napster.

Harvey et al. (U.S. 6,487,583 B1) discloses system for information and application distribution.

Henrick (U.S. 6,507,727 B1) discloses purchase and delivery of digital content using multiple devices and data networks.

Chacker (U.S. 6,578,008 B1) discloses online talent business through online distribution of content.

Fanning et al. (U.S. 6,742,023 B1) discloses use-sensitive distribution of data files between users and Napster.

IBM TDB-ACC-NO: NNRD44982 discloses catalog caching to improve search efficiency in distributed peer-to-peer file sharing systems.

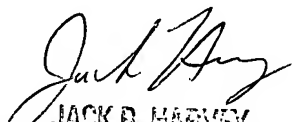
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (571) 272-3892. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached at (571) 272-3896. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER